

REMARKS

Claims 1-25 are currently pending in the application. Reconsideration of the rejected claims in view of the attached Declaration and following remarks is respectfully requested.

35 U.S.C. §112 Rejection

Claim 11 was rejected under 35 U.S.C. §112, 1st paragraph. This rejection is respectfully traversed.

The Examiner rejected Claim 11 for allegedly not having support for both an N-channel and P-channel transistors put together on the same substrate in the specification. Applicants do not agree with the Examiner. For example, support for both N-channel field effect transistors and P-channel field effect transistors on a substrate can be found in the last paragraph of page 7 which refers to Figure 1 and sets forth:

“substrate 100 having a polarity of FETS (i.e. N-FETS and/or P-FETS) 105-125”.

“similar devices are clustered; though the invention is applicable to devices having N-FETs interspersed with P-FETS, and visa versa.”

Accordingly, the specification clearly has support for having both N-FETS and P-FETS on a substrate. Additionally, referring to Figure 1 and the corresponding text in the specification, a substrate 100 is shown with FET 105, 110, 115 120, and 125 dispersed thereon. The associated text of the specification identifies the FETs as being either N-FETs and/or P-FETs.

As such, Applicants respectfully request that the rejection of Claim 11 be withdrawn.

Prior Art Rejections

Claims 1, 20, and 23 were rejected under 35 U.S.C. §102(e) over U.S. Patent Application Publication No. 2004/0135234 to Morin, *et al* (“Morin”). Claims 21 and 22 were rejected under 35 U.S.C. §103(a) over Morin. Claims 1-11 and 24-25 were rejected under 35 U.S.C. §103(a) over Morin in view of U.S. Patent No. 6,235,574 to Tobben, *et al.* (“Tobben”). Claims 12-19 were rejected under 35 U.S.C. §103(a) over Morin, Tobben and U.S. Patent No. 6,483,154 to Ngo, *et al.* (“Ngo”). Applicants submit that rejection of Claims 1-25 are rendered moot in view of the submitted declaration under 37 C.F.R. §1.131, by the named inventors.

Under § 1.131, a rejection under 35 U.S.C. § 102(e) or § 103(a) based on a patent may, upon a proper showing, be overcome by removing the patent as a reference against the claims. Applicants submit that the § 1.131 Declaration¹ submitted herewith is sufficient to remove the Morin patent under the § 102(e) rejection and the primary reference of the Morin patent under the §103(a) rejection, as a reference and thus is sufficient to overcome the above-noted rejections. More specifically, Applicants submit that the § 1.131 Declaration is formally and substantively sufficient to establish that the Inventors had completed the invention defined in at least claims 1, 11, 20 and 23 (and dependent claims) in the United States before the effective date of the Morin reference, i.e., November 4, 2003. The statements in the Declaration show that the formal requirements of § 1.131 is satisfied, namely:

- (1) the rejections to be overcome are under §§ 102(e) and 103(a);
- (2) all the acts for completing the invention of claims 1, 11, 20 and 23, and those claims dependent thereon were performed in the United States; and

¹ The § 1.131 Affidavit includes three partially executed signature pages, which were forwarded by facsimile for filing. The pages 1-4 were added by the law firm of the undersigned, which are identical to pages 1-4 and which were forwarded for execution.

(3) the effective date of the Morin reference (i.e., November 4, 2003) is not more than one year prior to the effective filing date of the present application.

It is respectfully submitted that the statements in the Declaration are also sufficient to satisfy the substantive requirements of 37 C.F.R. § 131. The Declaration sets forth specific facts, of sufficient character and weight, to establish a **date of conception** before November 4, 2003, the effective date of the Morin reference, and to show that the Inventors and their attorneys exercised **due diligence** from a time before the effective filing date of the Morin reference to a constructive reduction to practice, i.e., to the filing date of the application in the United States on November 6, 2003.

DATE OF CONCEPTION

As stated in the Declaration, the Inventors conceived a method and apparatus of at least claims 1, 11, 20 and 23 prior to the effective date of the Morin reference. An IBM Invention Disclosure is submitted with the Declaration as supporting evidence of this prior date of conception. The Invention Disclosure shows that the Inventors had a definite and permanent idea of the complete and operative invention of all the pending claims 1-25 prior to November 4, 2003, the effective date of the Morin reference.

In particular, the Invention Disclosure, textually and in Figures, shows the features of independent claims 1, 11, 20 and 23 (and dependent claims). Also, the Invention Disclosure shows a date antedating the November 4, 2003 effective date of the Morin reference. This and all other pertinent dates have been removed from the photocopies of the Invention Disclosure submitted with the Declaration to prevent any potential prejudice to Applicants.

Applicants further submit that the Declaration filed herewith shows, unequivocally, that the Inventors had in their possession a definite and permanent idea of the complete and operative invention of the pending claims before November 4, 2003 in a manner sufficient to satisfy the requirements of conception, as set forth in M.P.E.P. §§715.07 and 2138.04, and thus constitute

prima facie evidence of Applicants' date of conception of the invention in this country before the effective date of the Morin reference.

DUE DILIGENCE

Applicants further submit that the Declaration shows the Inventors and their attorneys exercised due diligence from a time before the November 4, 2003 effective date of the Morin reference to a constructive reduction to practice, realized by the filing of the above-identified parent application on November 6, 2003 in the United States. For example, the Invention Disclosure was forwarded to outside counsel in a timely manner. Discussions between the Inventors and counsel took place until a final application was forwarded to the Inventors for execution, and subsequent filing on November 6, 2003. Some discussions took place on, for example, October 10, 2003, October 20, 2003, October 21, 2003 and October 23, 2003, with the undersigned counsel.

Counsel acted in an expeditious manner to prepare the application for filing. Under M.P.E.P. § 2138.06, only *reasonable* diligence is required in this regard. More specifically, § 2138.06 states that a patent attorney will be held to have exercised reasonable diligence if the attorney worked reasonably hard on the application during the critical period, taking into consideration any backlog of unrelated cases the attorney may have had and his completion of those cases along with the present application in chronological order. Applicants respectfully submit that the Declaration shows that counsel acted sufficiently expeditiously to satisfy the requirements of due diligence.

Applicants submit that the Declaration submitted herewith is sufficient to show that due diligence was exercised as required under 37 C.F.R. § 131. The Inventors remained in regular contact with counsel to answer questions, provide technical explanation, and supply the disclosure materials necessary for allowing the application to be filed in an expeditious manner. Accordingly, Applicants respectfully request that the rejection over claims 1-25 be withdrawn.

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CONCLUSION

In view of the foregoing remarks, Applicants submits that all of the claims are patentably distinct from the prior art of record and are in condition for allowance. The Examiner is respectfully requested to pass the above application to issue. The Examiner is invited to contact the undersigned at the telephone number listed below, if needed. Applicants hereby make a written conditional petition for extension of time, if required. Please charge any deficiencies in fees and credit any overpayment of fees to International Business Machines Corporation's Deposit Account No. 09-0458.

Respectfully submitted,



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